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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,650	10/15/2001	Per Sjoberg	0459/00346	5908

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,650

Applicant(s)

SJOBERG, PER

Examiner

Edward A. Miller

Art Unit

3641

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 14-28 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 11, 15, 19-22 and 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 14, 16-18 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3641

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on March 29, 2004 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Applicant's prior election of Group I is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, as between Groups I and III, the election has been treated as an election without traverse (MPEP § 818.03(a)). Note that Group III now includes claim 15, in addition to claims 3 and 8. Applicant's remarks are noted as to claim 15, but this claim still recites recrystallizing the composition, and thus it still falls within Group III, that is claims 3, 8, 15 and possibly 27, as best understood.

4. A common special technical feature must serve to define over the prior art in accordance with PCT Rule 13.2. There is manifestly not a common special technical feature, as no claims define over the prior art. Note that Group II now includes 4-7, 11 and 19-21. Although claims 19-21 recite a method, they depend on and further limit claim 4, and thus they are considered as in Group II. Applicant has taken no action to correct any error than may exist in this regard.

5. Note 706.07(h), wherein one finds, in pertinent part:

"In addition, as 35 U.S.C. 132(b) and 37 CFR 1.114 provide continued examination of an application (and not examination of a continuing application), the applicant cannot file an RCE to obtain continued examination on the basis of claims that are independent and

Art Unit: 3641

distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions) (see 37 CFR 1.145).”

New Group IV, claims 22 and 24-28, is drawn to a method which includes burning the composition, as by adjusting the rate of burning. This new Group of invention is withdrawn from consideration as not being to the previously elected Group. The reasons in support of this holding of lack of unity are the same as in the case of the other Groups of invention. Although this Group is not entirely understood, this is as the claims are understood. Should applicant correct the claim language to be definite and present appropriate reasons, the lack of unity can be reconsidered. Applicant is required to adhere to the previous election, and thus Group IV is withdrawn from consideration.

6. Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

In these claims, per cent ranges of amounts of guanidine dinitramide are specified, such as “20% to 80% by weight of the gas releasing composition, not including the binder.” Applicants have not pointed out the basis therefore, and none is apparent. Applicants are required to point out the original specification basis therefore or to cancel the new matter. The new language, each word *arguendo* having basis, is such that the new concept, or the new expression as a whole, lacks original basis, when fairly viewed in context. Compare *In re Oda*, 170 USPQ 268, and *Ex part Grasselli*, 231 USPQ 393, as well as MPEP 706.03(o) and 2163-2163.06, where departures (including from cancellations, where each word has basis, but not the expression) from the original disclosure are

Art Unit: 3641

new matter. Also, as to ranges of ingredients, see *Ex parte Jackson*, 110 USPQ 561. Claim 1 recites a pyrotechnic material "comprising guanidine dinitramide and guanyl urea dinitramide as a gas-releasing composition...." Due to the "comprising" scope, numerous additional ingredients and in any amounts are permitted. However, applicants have provided no basis for the new range in claims 16-18, which recites amounts but only excludes a binder, without any basis for the range overall or for exclusion of the binder. There is no specification basis for such. This is particularly the case in view of the "not including" limitation. The argument based on the figure lacks merit, since the Figure relates solely to the A and B ingredients, and teaches nothing about excluding a binder.

7. Claims 1-2, 14, 16-18 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2 are indefinite. As best understood, claim 1 recites making a device by providing an unnamed safety device and placing a composition in the device. There is no method step in this recitation that relates to any device limitations. This language assumes a number of things not recited. For example, one may postulate a safety device which is a bumper, that includes a hollow portion that is open below. The composition could be placed in the hollow in hopes of providing a safety propellant effect, by hopefully repelling the bumper of a car that is impacting. However, there would be nothing recited to hold the composition in the hollow or upside down "U" shaped device. Thus, the language used is inconsistent with the body of the claim. The necessary claim elements, e.g., the apparatus parts are omitted. This omission amounts to a gap between the elements. See MPEP § 2172.01. The omitted structural cooperative relationships are that the claims are a method of making a device, but there are no device limitations or device related method steps recited. The newly added method step of "providing" and adding does not make any safety device. There is no

Art Unit: 3641

recitation of any parts or apparatus content of the apparatus, nor any assembly or other step to effectively prepare any device or apparatus. The language used is so indefinite that what is actually required by the claims, e.g., the metes and bounds, cannot reasonably be determined. The language may inherently have implied limitations not otherwise recited. Such are improper and contribute to the inability to define the metes and bounds of the claimed invention.

These exemplary problems render the claims indefinite, as it cannot be determined what the claimed invention is. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In claim 2, line 2, the term "amount to adjust the rate" is used, without any manner of, or parameters for, determining the amount. Assuming *arguendo* that the substances recited in claim 1 have different burning rates when in use, the claim 2 limitation is not a further limitation, but would be inherently always the case, as written. Should the burning rates when in use be identical, then the claim 2 limitation would never be true. In any event, claim 2 as amended remains indefinite, and appears improper as failing to further limit the subject matter of claim 1, 35 USC 112, 4th paragraph.

In claim 16-18, the recitation of "not including binder" is indefinite, as these claims recite that they do have a binder. This is inconsistent. The amounts are so indefinite that it is not possible to determine what applicant intended.

8. Claims 1-2, 14, 16-18 and 23 are rejected under 35 U.S.C. 103(a) as obvious over Blomquist, 6,004,410, in view of Langlet, WO 98/55428.

Blomquist '410 teaches airbag devices containing [provided with] GDN (guanidine dinitramide), for example, at col. 2, line 32. In instant claims 1-2, the amount of guanidyl urea dinitramide might be 0% to obtain the examiner's required burning rate, as use of only A or B is

Art Unit: 3641

disclosed in the drawing, to obtain certain properties. Likewise, "possible" amounts of binder include 0%, especially in claims 16-18, and more than 50% of GDN includes 100%. Thus, possibly no claim but claims 16-18 requires any additional ingredient beyond GDN. This is problematic due to the indefinite nature of the claims. To the extent appropriate, Blomquist '410 may be the epitome of obviousness, anticipation, as broadly construed. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The claim 14 "tablet" form is taught at col. 4, lines 63-67. In any event, it would have been clearly obvious to combine a plurality of ingredients to prepare a gas generating composition, where the properties of use in such are well known and the combination produces the expected result, a safety device of some utility. Thus, the device produced is an unspecified safety device having a propellant or gas generating material. There is nothing unobvious about preparing such devices, including by providing the propellant therefore. Langlet, WO 98/55428, teaches the similar use of guanidylurea dinitramide for the same purpose as the GDN of Bloomquist '410. Thus, combining the ingredients or the compositions to obtain the desired properties would have been obvious. Where the ingredients are well known and combined for their known properties, the combination is obvious, absent unexpected results, *In re Crockett*, 126 USPQ 186, *In re Pinten*, 173 USPQ 801, and *In re Sussman*, 43 CD 518. Further, it is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerckhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi*, 169 USPQ 423.

To the extent appropriate, variation of specific amounts (as in claims 16-18) and well known ingredients would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

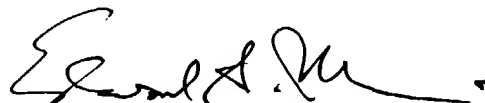
Art Unit: 3641

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward A. Miller whose telephone number is (703) 306-4163. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miller/em
July 4, 2004

A handwritten signature in black ink, appearing to read 'Edward A. Miller', with a stylized flourish at the end.

EDWARD A. MILLER
PRIMARY EXAMINER